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From: Wright, Lee C.
Sent: Sunday, June 05, 2005 11:39 PM
To: AB85 Comments
Subject:

Ms. Ferriter:

Please consider the following comments on the proposed rule changes entitled "Provisions for Persons Granted Limited Recognition to Prosecute Patent Applications and Other Miscellaneous Matters" (Fed. Reg. Vol. 70, No. 66, April 7, 2005

Respectively, Lee C. Wright (Reg. No. 41,441)

Rule 1.78(5)(iv)

1. Effective date/Grandfathering

The proposed rule package does not include any mention of how the proposed rule is to be implemented.

If the rule is effective for all provisional applications pending as of the date of the rule, such an effective date will cause great hardship to applicants of provisional applications almost one year old as of the effective date of the rule. That is, an applicant may have only one day (or less) depending on the promulgation date to comply with the rule.

A similar hardship would occur if the rule is effective for all nonprovisional applications pending as of the date of the rule. Further, application of the rule for all nonprovisional applications would be effectively a retroactive rule to be applied to abandoned provisional applications.

I suggest that the proposed rule be effective for provisional applications filed on or after the date of rule promulgation.

2. Clarity of the Rule and Conflict with 37 CFR 1.137(g)

The proposed rule allows for the "notice" to be sent in the nonprovisional application (see the phrase "[i]f the notice is mailed in a pending nonprovisional application.") In most circumstances such a notice would be sent when the provisional application is abandoned.

How can a notice in a nonprovisional application allow for a period of time to file a paper in a separate application, which is likely to already be abandoned?

It appears that this section is intended to allow for the filing of papers in an abandoned provisional application. However, unless the rule specifically states that the provisional application is revived by application of the proposed new rule, so that a paper may be entered, it is unclear how a notice in a separate application may allow for the filing of a paper in an abandoned application. If the rule is intended to allow for the revival of an abandoned provisional application the rules should explicitly state the provisional application may be revived to allow for entry of the English translation. Otherwise, the rule of automatic abandonment and the prohibition against entry of papers in an abandoned application would conflict with the proposed rule. Any procedure for revival of the provisional application should be by express rule, not my implication.

The proposed new rule appears to conflict with Rule 1.137(g). 1.137(g) only allows for revival of a provisional application in certain narrow circumstances:

> (g) *Provisional applications:* A provisional application, abandoned for failure to timely respond to an Office requirement, may be revived pursuant to this section. Subject to the provisions of 35 U.S.C. 119(e)(3) and § 1.7(b), a provisional application will not be regarded as pending after twelve months from its filing date under any circumstances.

As for the situation where the notice is sent in a provisional application, in the proposed rule there is no detrimental effect for not complying with such a notice. If a notice is mailed in the provisional application and the English translation and statement not made prior to abandonment of the provisional application, will a second notice be sent in the nonprovisional application?

3. **Revival of abandoned provisional applications.**

The rule as currently in effect does not cause the problems discussed below. In addition to the suggestions, the discussions below are also considered to be reasons for not changing rule 1.78(5)(iv).

Provisional applications are abandoned automatically. An applicant has no control over the abandonment date. That is, an applicant can not buy an extension of time in order to prepare and file the required translation. Additionally, an applicant may inadvertently or unintentionally not file the required translation in the provisional application.

In the proposed rule there are no explicit procedures for curing the defect of not filing the required translation in the provisional application prior to abandonment of the provisional application. This is a particularly harsh

result. I recommend that an explicit procedure be implemented to allow for the revival of a provisional application for the purposes of filing the required English language translation.

Similarly, there are currently no procedures for revival of an abandoned provisional application to correct a defect in an English language translation that was only discovered after the provisional application has been abandoned.

4. Effect of not Filing the English Language Translation in the Provisional Application Following a "Notice"

Proposed new rule 1.78(5)(iv) requires abandonment of the nonprovisional application if applicant does not comply with the "notice." (Yes, I realize that this provision is in the rule as currently in effect).

Why is abandonment necessary? Why not just deny claim to priority to provisional application and require that the application be so amended? The other provisions of 37 CFR 1.78, relating to 119 and 120 benefit do not require abandonment of the nonprovisional application, merely loss of the claim for priority. The Office has not shown a need for a different, harsher treatment of an ineffective claim for priority under 119(e) vs. under 119(a) or 120.

The proposed rule does not allow for prosecuting the application with the original nonprovisional filing date. An applicant can not amend to drop the claim for priority and keep the original nonprovisional application filing date. This is a particularly harsh rule.

5. What is the effect of the Office not issuing a "notice"?

What is the effect of the Office not issuing a "notice"?

Please also comment on the Office's previous stated position: "[i]n the event that the Office schedules an application that claims the benefit of a provisional application filed in a language other than English for publication without issuing a notice requiring the applicant to file English language translation of the non-English language provisional application, the applicant should file the English language translation of the non-English language provisional application and a statement that the translation is accurate before the scheduled publication date." Fed. Reg. Vol. 66, No. 249, December 28, 2001.

6. Need for New Rule

I do not believe that the ease to be able to see which papers filed are the original specification and which papers are the English language translation is a difficult task for attorneys and examiners skilled the art of application prosecution and examination. The extra storage of multiple copies is also not a great weight as normally for most applications only a small number of continuation/divisional applications are filed.

Further, the proposed rule does not consider many details as discussed above and promulgating the rule as apparently intended would require greater complexity. The burdens caused by the changes in the rule do not outweigh the need for changes.